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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,318	04/03/2001	Adolf Stender	64251-022	2510

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EXAMINER	
RIBAR, TRAVIS B	

ART UNIT	PAPER NUMBER
1711	11

DATE MAILED: 10/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

Office Action Summary	Application No.	Applicant(s)	
	09/825,318	STENDER ET AL.	
	Examiner	Art Unit	
	Travis B Ribar	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *22-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The amendment filed on August 14, 2002 overcomes the rejections made under 35 USC 112 in the prior office action.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanno et al. in view of von Bittera et al.

Kanno et al. shows an adhesive sheet that comprises a tacky polymer with an elastic microsphere filler (column 1, lines 15-16 and column 6, lines 38-42). The tacky polymer is not particularly limited, and includes any polymer materials commonly used as adhesives, including polyurethane (column 5, lines 28-33). The elastic microspheres in Kanno et al. have a diameter of 10 picometers to 250 microns (column 6, lines 3-5, and applicant's claim 7) and are made from an acrylic polymer (column 6, lines 15-19 and applicant's claim 2). The composition in Kanno et al. is shown to include as low as 9.1% elastic microspheres by weight of the entire material (column 4, lines 33-42). The 9.1% by weight value is obtained by dividing the 10 weight parts of elastic microspheres by the 110 weight parts of the total composition, made from 100 weight parts tacky polymer and 10 weight parts elastic microspheres. Kanno et al. therefore meets those parts of the applicant's claims 1, 2, 7, and 8.

However, Kanno et al. does not explicitly state that polyurethane gel is the adhesive in the invention. Von Bittera et al. discloses that polyurethane gel is a commonly used adhesive that is useful in such applications as medical adhesives. Further, the polyurethane gel is made from a composition that meets the restrictions of claims 14 and 15 (column 2, lines 3-52).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the polyurethane gel adhesive shown in Von Bittera et al. as the adhesive in the invention in Kanno et al. The motivation for doing so would be to obtain an adhesive useful for medical applications. Therefore it would have been obvious to combine von Bittera et al. with Kanno et al. to obtain the invention as specified in claims 1, 2, 7, 8, 14, and 15.

4. Claims 1, 9, 11-13, and 16 are rejected under 35 U.S.C. 103(e) as being unpatentable over Burgdorfer et ál. in view of Steppan et al. and Abe.

Burgdorfer et al., cited by the applicant in their IDS form 1449, teaches an undercured polyurethane gel meeting the applicant's claim 9, which may optionally include a filler (claim 1). The claimed isocyanate and polyol in Burgdorfer et al. are also the same as the applicant's. The isocyanate functionality of the polyol meets the requirements that the applicant sets forth in claims 11-13 (claims 1 and 4) and the isocyanate (page 5, lines 39-46) is the same as that claimed by the applicant in claim 16.

Burgdorfer et al. does not include the use of elastic microsphere fillers, however. Elastic microsphere fillers in polyurethane compositions are well known in the art and are seen in Steppan et al. (column 10, lines 16-49) and Abe (column 4, lines 21-46). The elastic microspheres are useful for decreasing the density of the polyurethane compositions and for allowing air to escape from an adhesive-substrate interface during application.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use elastic microspheres such as those in either Steppan et al. or Abe in the adhesive composition in Burgdorfer et al. The motivation for doing so would be to decrease the density of the adhesive and to allow air to escape the interface between the adhesive and the substrate during application. Therefore it would have been obvious to combine Steppan et al. or Abe with Burgdorfer et al. to obtain the invention as specified in claims 1, 9, 11-13, and 16.

5. Claims 1-11, 14-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Bittera et al. in view of Steppan et al.

The prior office action contains the text of this rejection, though the examiner now notes that with the amendment to claims 14 and 15 filed August 14, 2002, von Bittera et al. also anticipates claims 14 and 15 because the polyurethane gel in the reference is made from a composition that meets the restrictions of the applicant's claims 14 and 15 (column 2, lines 3-52).

6. Claims 1-3, 7, 9-11, 14-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Bittera et al. in view of Abe.

The prior office action contains the text of this rejection, though the examiner now notes that with the amendment to claims 14 and 15 filed August 14, 2002, von Bittera et al. also anticipates claims 14 and 15 because the polyurethane gel in the reference is made from a composition that meets the restrictions of the applicant's claims 14 and 15 (column 2, lines 3-52).

7. Claims 4-6 rejected under 35 U.S.C. 103(a) as being unpatentable over von Bittera et al. in view of Abe as applied to claim 2 above, and further in view of Steppan et al.

The prior office action contains the text of this rejection.

8. Claims 1-2, 7-11, 14-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Bittera et al. in view of Kanno et al.

The prior office action contains the text of this rejection, though the examiner now notes that with the amendment to claims 14 and 15 filed August 14, 2002, von Bittera et al. also anticipates claims 14 and 15 because the polyurethane gel in the reference is made from a composition that meets the restrictions of the applicant's claims 14 and 15 (column 2, lines 3-52).

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Bittera et al. in view of Steppan et al. as applied to claim 1 above, and further in view of Konig et al.

The prior office action contains the text of this rejection.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Bittera et al. in view of Abe as applied to claim 1 above, and further in view of Konig et al.

The prior office action contains the text of this rejection.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Bittera et al. in view of Kanno et al. as applied to claim 1 above, and further in view of Konig et al.

The prior office action contains the text of this rejection.

12. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burgdorfer et al. in view of Steppan et al.

The prior office action contains the text of this rejection.

Response to Arguments

13. Applicant's arguments filed August 14, 2002 regarding the rejections made under 35 USC 103 in the prior office action have been fully considered but they are not persuasive.

14. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. Regarding the applicant's arguments with regard to von Bittera et al., the applicant argues that the reference discloses crosslinked polyurethane, whereas the present application describes a polyurethane gel. The examiner notes that the crosslinked polyurethane in the reference does not preclude the existence of a gel in the invention, and it is well known in the art that gels are crosslinked materials. Therefore, the application of this reference stands.

16. The applicant also argues that the microspheres in Steppan et al. are not the same as the microspheres that the applicant claims. However, the microspheres in Steppan et al. are the same microspheres that the applicant cites as useful in their invention (e.g. page 7, line 28 of the specification). Since the microspheres in the

reference and in the application are the same, this reference does meet the requirements of the claims to which it is applied.

17. The applicant's arguments with regards to Kanno et al. involve the use of elastic microspheres as filler. The applicant argues that in Kanno et al., the elastic microspheres are not used as filler. The examiner respectfully disagrees. The elastic microspheres in the reference are non-reactive components of the composition and therefore constitute filler. The examiner also believes that the figures that the applicant cites (figures 1a and 1g in Kanno et al.) show the elastic microspheres as filler in the adhesive composition. The application of this reference therefore stands.

18. The applicant's arguments regarding Konig et al. reflect the fact that Konig et al. does not explicitly state that the composition it discloses is used to produce a polyurethane gel. Konig et al. does disclose that the composition can be made into many different types of polyurethanes, without limiting those types. The rejections in which this reference appears depend on the other references to disclose that polyurethane gels are anticipated. The application of this reference also stands.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar
Examiner
Art Unit 1711

TBR
October 21, 2002

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700